



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/605,628	02/22/1996	CHARLES B. SIMONE	S4264.000/P0	8170

24998 7590 11/07/2005

DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP  
2101 L Street, NW  
Washington, DC 20037

EXAMINER

PORTER, RACHEL L

ART UNIT	PAPER NUMBER
----------	--------------

3626

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

08/605,628

Applicant(s)

SIMONE, CHARLES B.

Examiner

Rachel L. Porter

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to the amendment filed 8/15/05. Claims 1-9 are pending.

***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/15/05 has been entered.

***Claim Rejections - 35 USC § 101***

3. The rejections of claims 7-8 under 35 U.S.C. 101, for not incorporating the technological arts are hereby withdrawn.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,2,4,4,6-7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dewey et al (USPN 5,084,819) in view of McDonnell ("Paying for Health Eager to Control Health-Care Costs...")

[claim 1] Dewey discloses a computer system for evaluating at least one individual, comprising:

- survey means for gathering information into a computer system database pertaining to said individuals' lifestyle, health, and medical tests in the form of a plurality of survey questions; (Figure 3; Table 1; col. 3, lines 64- col. 4, line 19; col. 8, lines 43-50)
- entry means for inputting said gathered information; (col. 3, lines 9-16; lines 25-29; lines 35-42)
- a computer system database for receiving and storing said gathered information; (col. 3, lines 9-42; col. 8, lines 43-50 )
- means for verifying said gathered information; (col. 3, lines 43-46; col. 4, lines 35-56—system contains validation and error checking components)
- means for assigning weight values in a weighting file in said computer system database,(col. 3, lines 46-52) said weight values being assigned by analyzing the present and future effects of said gathered information; (col. 6, lines 20-46; Tables 2 and 3)
- means for determining a total value based upon said assigned risk values and said assigned weight values for all of said gathered information; (col. 5, line 51- col. 6, line 47)

- choosing means for selecting certain gathered information and certain pre-defined suggestions on medical and lifestyle choices that would lead to improving health and decreasing risk and that have similar subject matter to said gathered information; (col. 6, line 61-col. 8, line 10; Tables 4-5)
- evaluating means for comparing each of said total values for said gathered information with pre-defined accepted values and for comparing said chosen pre-defined suggestions with said gathered information wherein pre-defined suggestions are selected that are specific and closely-tailored to said gathered information and to the needs of said individual, including recommendations for treatment of health problems and for altering lifestyle to ensure better future health; (Tables 4-5; col. 6, lines 19-47; col. 6, line 61-col. 7, line 16)
- messaging means for providing messages that contain said pre-defined suggestions; (col. 7, lines 28-col. 8, line 41)

Dewey discloses a system for evaluating the health and lifestyle of at least on individual substantially as described above. Dewey further discloses that that system may be used by various groups including businesses and employers for counseling purposes, but does not expressly disclose the use of the system for insurable risk assessment. McDonnell teaches a system/method in which health assessments are performed on insureds/employees. (McDonnell: par. 12-14) McDonnell further discloses that the individuals are advised on reducing their health risks and given information on how health risks correlate to a reduction or discounts in their insurance premiums (i.e.

assigning risk values to each of said weight values that represent levels of insurance risk and analyzing means for determining the level of insurance risk such that both a cost and an insurability profile are determined; communication of level of insurance risk/premium changes—McDonnell: par. 12-14) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Dewey with the teaching of McDonnell to use the health assessments to evaluate insurability and insurance risk. As suggested by McDonnell, one would have been motivated to include this feature to slow the growth of healthcare costs (McDonnell: par. 2) and to provide insureds with specific health information to reduce insurance costs while improving their health (McDonnell: par. 33)

[claim 2] Dewey and McDonnell disclose the system of claim 1 as explained in the rejection of claim 1. Furthermore, McDonnell discloses a method in which the individuals are advised on reducing their health risks and are given information on how health risks correlate to a reduction or discounts in their insurance premiums (i.e. assigns negative values for actions that increase insurance risk and positive values for actions that decrease insurance risk.) (McDonnell: par. 12-14) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Dewey with the teaching of McDonnell. As suggested by McDonnell, one would have been motivated to include this feature to slow the growth of healthcare costs (McDonnell: par. 2) and to provide insureds with specific health information to reduce insurance costs while improving their health (McDonnell: par. 33)

[claim 4] Dewey discloses a computer system further comprising a questionnaire database means to store a questionnaire said questionnaire being employed by said survey means in order that such individual can select appropriate responses to lifestyle questions. (col. 3, lines 9-52; Table 1; col. 4, lines 67-col. 5, lines 35; col. 8, lines 43-48)

[claim 6] Dewey discloses a system for evaluating individuals wherein said gathered information about lifestyle includes tobacco use (Dewey: Table 1; col. 4, line 67-col. 5, line 9), but does not expressly disclose gathering information on alcohol use and food intake. McDonnell discloses a system/ method wherein gathered lifestyle information includes alcohol use and food intake (i.e. diet/weight loss). (par. 14, 28) At the time of the Applicant's invention it would have been obvious to one of ordinary skill in the art to system/method of Dewey with the teaching of McDonnell to gather information on alcohol use and food intake. As suggested by McDonnell, one would have been motivated to include this feature to encourage insureds to alter poor health habits and reduce the overall costs of health care (par. 33)

[claim 7] Dewey teaches a method of evaluating in a computer system at least one individual, comprising the steps of:

- gathering information pertaining to lifestyle, health, and medical tests; (Figure 3; Table 1; col. 3, lines 64- col. 4, line 19; col. 8, lines 43-50)

Art Unit: 3626

- receiving and storing said gathered information in a database in said computer system ((col. 3, lines 9-42; col. 8, lines 43-50 )
- verifying said gathered information; (col. 3, lines 43-46; col. 4, lines 35-56—system contains validation and error checking components)
- assigning of weight values by said computer system for each of said stored information, (col. 3, lines 46-52) said weight values being assigned by analyzing the present and future effects of said gathered information; (col. 6, lines 20-46; Tables 2 and 3)
- the computer system determining a total value based upon said assigned risk values and said assigned weight values for all of said gathered information for such individual; (col. 5, line 51-col. 6, line 47)
- choosing certain gathered information and certain pre-defined suggestions on medical and lifestyle choices that would lead to improving health and decreasing risk and that have similar subject matter to said gathered information; (col. 6, line 61-col. 8, line 10; Tables 4-5)
- comparing said chosen pre-defined suggestions with said gathered information wherein pre-defined suggestions are selected that are specific and closely-tailored to said gathered information and to the needs of said individual, including recommendations for treatment of health problems and for altering lifestyle to ensure better future health; (Tables 4-5; col. 6, lines 19-47; col. 6, line 61-col. 7, line 16)
- providing messages from said computer system that contain said pre-defined suggestions; (Tables 4-5; col. 6, lines 19-47; col. 6, line 61-col. 7, line 16)



Dewey discloses a system for evaluating the health and lifestyle of at least one individual substantially as described above. Dewey further discloses that that system may be used by various groups including businesses and employers for counseling purposes, but does not expressly disclose the use of the system for insurable risk assessment. McDonnell teaches a system/method in which health assessments are performed on insureds/employees. (McDonnell: par. 12-14) McDonnell further discloses that the individuals are advised on reducing their health risks and given information on how health risks correlate to a reduction or discounts in their insurance premiums (i.e. assigning risk values to each of said weight values that represent levels of insurance risk and analyzing means for determining the level of insurance risk such that both a cost and an insurability profile are determined; communicating level of insurance risk/premium changes—McDonnell: par. 12-14) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Dewey with the teaching of McDonnell to use the health assessments to evaluate insurability and insurance risk. As suggested by McDonnell, one would have been motivated to include this feature to slow the growth of healthcare costs (McDonnell: par. 2) and to provide insureds with specific health information to reduce insurance costs while improving their health (McDonnell: par. 33)

[claim 9] Dewey teaches a computer system for evaluating at least one individual, comprising:

Art Unit: 3626

- a computer system database; (col. 3, lines 9-42; col. 8, lines 43-50)
- a survey unit for gathering information into said computer system database pertaining to said individuals' lifestyle, health, and medical tests in the form of a plurality of survey questions; (Figure 3; Table 1; col. 3, lines 64- col. 4, line 19; col. 8, lines 43-50)
- an entry unit for inputting said gathered information; (col. 3, lines 9-16; lines 25-29; lines 35-42)
- a verifier for verifying said gathered information; (col. 3, lines 43-46; col. 4, lines 35-56—system contains validation and error checking components)
- a weight analyzer for assigning weight values in a weighting file in said computer system database, (col. 3, lines 46-52) said weight values being assigned by analyzing the present and future effects of said gathered information; (col. 6, lines 20-46; Tables 2 and 3)
- a summing unit for determining a total value based upon said assigned risk values and said assigned weight values for all of said gathered information; (col. 5, line 51- col. 6, line 47)
- a selector for selecting certain gathered information and certain pre-defined suggestions on medical and lifestyle choices that would lead to improving health and decreasing risk and that have similar subject matter to said gathered information; (col. 6, line 61-col. 8, line 10; Tables 4-5)
- a comparator for comparing each of said total values for said gathered information with pre-defined accepted values and for comparing said chosen pre-defined

suggestions with said gathered information, wherein pre-defined suggestions are selected that are specific and closely-tailored to said gathered information and to the needs of said individual, including recommendations for treatment of health problems and for altering lifestyle to ensure better future health; (Tables 4-5; col. 6, lines 19-47; col. 6, line 61-col. 7, line 16)

- a messaging unit for providing messages that contain said pre-defined suggestions; (col. 7, lines 28-col. 8, line 41)

Dewey discloses a system for evaluating the health and lifestyle of at least on individual substantially as described previously. Dewey further discloses that that system may be used by various groups including businesses and employers for counseling purposes, but does not expressly disclose the use of the system for insurable risk assessment. McDonnell teaches a system/method in which health assessments are performed on insureds/employees. (McDonnell: par. 12-14) McDonnell further discloses that the individuals are advised on reducing their health risks and given information on how health risks correlate to a reduction or discounts in their insurance premiums (i.e. assigning risk values to each of said weight values that represent levels of insurance risk and analyzing means for determining the level of insurance risk such that both a cost and an insurability profile are determined; communicating level of insurance risk/premium changes—McDonnell: par. 12-14) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Dewey with the teaching of McDonnell to use the health assessments to evaluate insurability and insurance risk. As suggested by McDonnell, one would

have been motivated to include this feature to slow the growth of healthcare costs (McDonnell: par. 2) and to provide insureds with specific health information to reduce insurance costs while improving their health (McDonnell: par. 33)

6. Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dewey et al (USPN 5,084,819) and McDonnell ("Paying for Health Eager to Control Health-Care Costs...") as applied to claims 1 and 7 above, and in further in view of DeTore (USPN 4,975,840)

[claim 3] Dewey and McDonnell in combination disclose the system of claim 1 as explained in the rejection of claim 1, but do not expressly a computer system further comprising a (second) database to store underwriter information including said risk values and said weight values. DeTore et al. disclose a system for evaluating insurable risk comprising a memory/database to store underwriter information (fig. 1, elements 24 and 26). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to further modify the combination of Dewey and McDonnell to include a database to system the underwriting information and weighting information. As suggested by DeTore, one would have been motivated to include this feature to provide a system that improves the overall processes associated with evaluating risks by increasing access to information, coordinating information from multiple sources, and evaluating insurability in a more consistent manner. (DeTore: col. 1, lines 44-58)

Art Unit: 3626

[claim 8] Dewey and McDonnell teach the method of claim 7 as explained in the rejection of claim 7. However, Dewey and McDonnell in combination do not expressly disclose that the individual is provided with the survey through the computer system. However, Dewey does disclose providing the individual with a survey/questionnaire (Table 1) and receiving the individual's answers from a questionnaire into the computer system (col. 8, lines 43-55). DeTore discloses a method wherein the step of gathering information also comprises the steps of providing said individual with a questionnaire through said computer system (col. 12, lines 62-66). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to further modify the combination of Dewey and McDonnell with the teaching of DeTore to administer the questionnaire using the computer system. As suggested by DeTore, one would have been motivated to include this feature to provide a system that facilitates several processes associated with evaluating risks by increasing access to information, coordinating information from multiple sources, and evaluating insurability in a more consistent manner. (DeTore: col. 1, lines 44-58)

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dewey et al (USPN 5,084,819) and McDonnell ("Paying for Health Eager to Control Health-Care Costs...") as applied to claim 1 above, and in further in view of Lynch ("Stay Healthy: Pay Le\$\$ for Health Insurance)

[claim 5] Dewey and McDonnell in combination disclose the system of claim 1 as explained in the rejection of claim 1. Furthermore, Dewey discloses a system wherein

Art Unit: 3626

predefined suggestions are automatically differentiated by said computer system for specific users (Tables 3-5; col. 6, line 61-col. 7, line 30; col.7, lines 64-col. 8, line 10), but does not expressly disclose recommendations for pregnant users. Lynch discloses a system wherein insurance companies conduct risk assessments and provide health recommendations and health education specifically for pregnant individuals/insureds. (Lynch: par. 16-17) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to further modify the method of Dewey and McDonnell with the teaching Lynch to provide health recommendations to pregnant users. As suggested by Lynch, one would have been motivated to include this feature to help manage maternity claims costs, reduce the number of high risk deliveries, decrease maternity related work absences, and to reduce infant and maternal mortality rates (Lynch: par. 18)

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

Art Unit: 3626

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RP  
RP

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600